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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,507	10/23/2001	Marlin Stephen Heilman	001086	3933

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EXAMINER

RAMANA, ANURADHA

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,507

Applicant(s)

HEILMAN ET AL.

Examiner

Anu Ramana

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 23-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-20 and 23-38 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The Examiner approves the drawing change submitted in the response filed on February 9, 2004. The Applicant is requested to submit a formal drawing incorporating the above change prior to allowance of the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-20 and 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The purpose of method step "g" in the amended independent claim 16 is unclear. Appropriate clarification or amendment is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-10, 13-16, 18-19, 23, 25, 27-30 and 33-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Sherman et al. (US 5,891,159).

Sherman et al. disclose an apparatus for attaching a conduit to a vessel including an enclosure 12 with a port 76 for evacuating air therefrom, a tool 116 with a holding member 117, a conduit 14, an attachment portion or sewing cuff 26 separable from enclosure 12 (Figures 4, 12, 16A and 16B, col. 1, lines 13-19, col. 8, lines 25-31 and lines 54-66, col. 9, lines 53-67, col. 10, lines 1-18, col. 13, lines 42-67, col. 14, lines 1-2, col. 16, lines 37-48, and col. 17, lines 21-65).

Art Unit: 3732

The method steps of claims 16, 18, 19, 23, 36 and 37 are inherently performed during normal use of the Sherman et al. enclosure for attaching a conduit to a vessel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8-10, 13-20, 23-26, 28-30 and 33-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. in view of Leahy et al. (US 5,813,409).

Sherman et al. disclose a conduit 12 attachable to a wall of a vessel 60 via a separable attachment portion or sewing cuff 26 and a tool 105 having a holding member 115 insertable through conduit 12 (Figures 4, 16A and 16B, col. 1, lines 13-19, col. 8, lines 25-31 and lines 54-66, col. 9, lines 53-67, col. 10, lines 1-18, col. 13, lines 42-67, col. 14, lines 1-2, col. 16, lines 37-48, and col. 17, lines 21-65).

Sherman et al. do not disclose an enclosure evacuated or filled with fluid. Leahy et al. teach a flexible fluid-tight envelope or enclosure filled with insufflation fluid with an access port to provide a sterile environment for insertion of surgical instrumentation wherein the enclosure has an attachment portion or "peel-strip backing" that is separable from the enclosure. (Figure 5, col. 1, lines 10-14 and col. 5, lines 41-58).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided an envelope around conduit 12 of Sherman et al. to provide a sterile aseptic environment while performing surgery, as taught by Leahy et al.

Regarding claim 2, it is the Examiner's position that evacuating the chamber of air is equivalent to filling the chamber with insufflation fluid such as saline for an aseptic environment.

Art Unit: 3732

In view of the above discussion, the method steps of claims 16-20, 23-24 and 36-38 are performed during normal use of apparatus of the combination of Sherman et al. and Leahy et al. for attaching a conduit to a vessel.

Claims 11, 12, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sherman et al. in view of Leahy et al., further in view of Mollenauer et al. (US 6,077,277).

Sherman et al. do not disclose a tool member with a rotatable barrel member having a cutting blade surrounding a central rod member.

Mollenauer et al. teach a tool member having a rotatable outer tube or barrel member having a cutting blade 46 wherein the central rod can be manipulated to hold material and the outer tube can be rotated to cut material (Fig. 8, col. 1, lines 55-67 and col. 5, lines 5-49).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have substituted the tool of Sherman et al. with the tool of Mollenauer et al. for simultaneous grasping and cutting of tissue.

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicants' arguments filed under "REMARKS" in Paper No. 7, filed on February 9, 2004, have been fully considered but are not persuasive.

Regarding Applicants' arguments with respect to independent claims 1, 16, 25 and 36, on pages 13-14, that Sherman et al. does not disclose an "attachment portion separable from the remainder of said enclosure", the Examiner directs Applicants' attention to Figure 4 of Sherman et al. wherein conduit or enclosure 12 is shown to have a separable attachment portion 26.

Regarding Applicants' arguments with respect to the 35 U.S.C 103 (a) rejections on Page 14, the Examiner directs Applicants' attention to col. 3, lines 14-23, wherein it is stated that the

Art Unit: 3732

Leahy enclosure has an attachment portion or "peel-strip backing" that is separable from the enclosure.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (703) 306-4035. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached at (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AR *Anuradha Ramana*
April 18, 2004

Kevin Shaver
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